

## **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed May 30, 2006. Claims 23 and 15 are cancelled, claims 13, 20, and 24 are amended. Claims 1-14, 16-22, and 23-39 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **I. Allowed Subject Matter**

The Examiner has indicated that claims 15 and 23-24 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants have rewritten claims 13 and 20 so as to include all of the limitations of claims 15 and 23 respectively. Claim 24 has been amended to depend from claim 20. As acknowledged by the Examiner, those claims are patentably distinct from the prior art, and are now in a condition for allowance. Moreover, for at least the same reason, claims now depending from claims 13 and 20 – namely, claims 14, 21-22, 24-27, and 36 – are also in condition for allowance.

### **II. PRIOR ART REJECTIONS**

#### **A. Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 1-14, 16-22, and 25-39 under 35 U.S.C. § 103 as being unpatentable over *Ahrens et al.* (U.S. Patent No. 6,789,958) in view of *Gregory* (U.S. Patent No. 6,305,848).

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

The Examiner has not established proper motivation for the proposed combination of *Ahrens* and *Gregory*. Rather, it appears clear that the rejection is based on impermissible hindsight reconstruction of the claimed invention as discussed below.

*Gregory* teaches a plurality of daughter cards, each of which is permanently connected to the mother board on one end and a single optical sub-assembly on the other end. Col. 5, lines 63-67. *Gregory* does not relate to independent removal of optoelectronic devices or latching devices for securing optoelectronic devices to a board. Rather, each optical subassembly 28 is mounted and soldered to a daughter card 20 (col. 5, lines 63-67) and each daughter card is connected to the back-edge of a mother board (col. 6, lines 27-28). The combination of the optical subassemblies 28, daughter cards 20, and mother board 14 operate as a single “high density blindmate optoelectronic module 10” for simultaneous insertion into a rack (see Figure 1)

and simultaneous connection of the optical subassemblies 28 to the optical connector 12 located on the backplane of a chassis. Col. 4, lines 60-62.

*Ahrens*, on the other hand, relates to release mechanisms for pluggable fiber optic transceiver connected directly to a single host circuit board 130. Thus, the single host circuit board 130 is not a daughter card as alleged by the Examiner as it is not operably connected to a mother board as required by the claims. However, the Examiner has combined the teachings of *Ahrens*, as to removability of each optoelectronic device, with *Gregory* to assert that such modification would be obvious. Such teachings are in direct contrast to the teachings of *Gregory* and *Ahrens*, and these teachings exist only in the Applicant's claimed invention. As such, the rejection is improper as being based on impermissible hindsight reconstruction.

As here, it is error to reconstruct the Applicant's claimed invention from the prior art by using the Applicant's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the Applicant's invention itself. *Interconnect Planning Corp v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985). Where the sole source of teaching or suggestion for placing a removable transceiver on a daughter card exists only in the Applicant's specification it is clear that the Examiner has engaged in impermissible hindsight reconstruction. As such, the proposed combination is improper and the Applicants respectfully request that the rejection of claims 1-14, 16-22, and 25-39 be withdrawn.

Moreover, the Examiner has not established a reasonable expectation of success because the Examiner has not established that the proposed combination of *Ahrens* and *Gregory* would be satisfactory for their intended purpose. *Gregory* teaches a high-density blindmate optoelectronic module 10 including a transceiver mounting block that defines a plurality of apertures 18. Each aperture 18 receives a connectorized optical subassembly 28. Col. 5, lines 17-20. In fact, *Gregory* teaches that a tight fit between the front surfaces 74 of the connectorized optical subassemblies and the front surfaces 45 of the connector ferrules formed within the mating connector 12 is desirable (col. 6, lines 33-39), in effect preventing one from removing a transceiver as suggested by the Examiner. "Once the mother board 14 is fully inserted into the printed circuit board support rack, the front surfaces 74 of the connectorized optical subassemblies 28 will abut and be biased against the front surfaces 45 of the connector ferrules 42 within optical connector 12." (Emphasis added). Therefore, if the teachings of *Ahrens* were

combined with the teachings of *Gregory* as suggested by the Examiner one would no longer be able to remove the fiber optic transceivers because the front of the fiber optic transceivers would be abutted against a connector in the back of the chassis as taught by *Gregory*. Therefore, the transceivers would effectively be inaccessible. One would be required to remove the entire mother board 14 of *Gregory* from the rack every time one desired to remove or replace a transceiver which is not contemplated or suggested by either reference. As such, the proposed combination is improper as rendering the proposed device unsatisfactory for its intended purpose and the Applicants respectfully request that the rejection of claims 1-14, 16-22, and 25-39 be withdrawn.

The Examiner also asserts that “[s]uch mother/daughter card arrangements are painfully well known in the art and are commonly used in communication devices to provide multiple channels.” Whether a single element of a claim is known is irrelevant as to the claimed combination of elements. Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir.1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Such combination of references cannot be applied if it would render the prior art non-functional or unsatisfactory for its intended purpose as described above. *See* MPEP 2145 X D. Moreover, such references cannot be applied if the references teach away from the proposed combination as also discussed above. *See* MPEP X D 2.

Moreover, with regard to the rejection of claim 11, the Examiner asserts that LC type duplex optical fiber connectors “are known to include a connector latch and a release sleeve (conventionally thermoplastic material) slidably engaged with the connector for connection/disconnection.” The Examiner submits no evidence of such allegation, however. In connection with the foregoing, Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claim 11. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i)

specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claim 11 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claim 11.

### **CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 2nd day of October, 2006.

Respectfully submitted,

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